

REMARKS

Applicants acknowledge receipt of a Non-Final Office Action (“Action”) dated September 25, 2006. In this response Applicants amend claims 1, 2, 4 and 11, and add new claims 32-34. Claims 6-9 and 19 are canceled. Following entry of these amendments, claims 1-5, 10-18, and 32-34 are pending in this application.

No new matter has been introduced. Support for the amendments to the following claims can be found, e.g., in the following places in the specification as originally filed:

- Claim 1 – paragraphs [0015] and [0021] and claims 6 and 7 as originally filed;
- Claims 32 and 33 – paragraphs [0006] and [0014]; and
- Claim 34 – paragraphs [0016] and [0044] and claim 19 as originally filed.

The amendments to claims 2 and 4 are made for clarity, and that to claim 11 is merely a grammatical correction.

Reconsideration of the present application is respectfully requested in view of the foregoing amendments and the remarks which follow.

Objection to the Specification

On page 2 of the Action, the PTO objects to the reference to “FIG. 14” in paragraph [0051]. The sentence referring to FIG. 14 has been deleted.

Objection to Claims

On page 2 of the Action, the PTO objects to the form of claim 19. Claim 19 has been canceled and new claim 34, in proper dependent form, has been added.

Rejections under 35 U.S.C. §102

On page 3 of the Action, claims 1-14, 17 and 19 are rejected under 35 U.S.C. § 102(b) for allegedly being anticipated by WO 1999/26724 to Muir *et al.* (“Muir”). Under § 102, a single prior art reference can anticipate a claim only if it discloses, either expressly or inherently, each and every feature of the claim. *In re Schreiber*, 128 F.3d 1473, 1477 (Fed. Cir. 1997).

Muir cannot anticipate any of the claims because it does not disclose each and every feature of any of the claims. Present claim 1 recites that “each of the compartments is arranged as a protruding element from the container.” Even assuming *arguendo* that Muir’s “sample entry” corresponds to the container, Muir’s “compartments A-H [in Fig. 5 do *not*] protrude from the side of the sample entry,” contrary to the PTO’s assertion (page 4, Action). Rather, compartments A-H are *aligned linearly* with one another. Because of the linear alignment of the compartments, Muir’s device comprising compartments A-H is *not* designed for testing blood stored for different amounts of time in the container after blood collection.

By contrast, the fact that “each of the compartments is arranged as a protruding element from the container” in the present invention facilitates testing of blood and detection of pathogens in the blood, where the blood is stored for *different amounts of time* in the container after the blood has been collected (see, e.g., Fig. 1). The present disclosure describes the importance of testing blood stored for different amounts of time after blood collection (see, e.g., paragraph [0004]).

Since Muir fails to disclose each and every feature of any of the claims, Muir cannot anticipate any of the claims. Accordingly, Applicants respectfully request withdrawal of the rejections of claims 1-14, 17 and 19 under § 102(b) over Muir.

Rejections under 35 U.S.C. § 103

On page 6 of the Action, claims 14-17 are rejected under 35 U.S.C. § 103(a) as allegedly being obvious over Muir in view of U.S. Pat. 5,589,332 to Shih *et al.* (“Shih”). Further, on page 9 of the Action, claim 18 is rejected under § 103(a) over Muir in view of Shih and U.S. Pat. 6,251,599 to Chen *et al.* (“Chen”). Finally, on page 9 of the Action, the PTO also rejects claim 18 under § 103(a) over Muir in view of Chen alone.

A *prima facie* case of obviousness has three requirements. First, a single prior art reference or a combination of references must teach or suggest each and every claim feature of the claimed invention. *In re Royka*, 490 F.2d 981, 984-85 (CCPA 1974). Second, there must be some reason, motivation, or suggestion to modify the single reference or combine the references in order to make the claimed invention. *In re Vaeck*, 947 F.2d 488, 493 (Fed. Cir. 1991). Third, the prior art must provide “a reasonable expectation of success” that modifying

the single reference or combining the references would result in the claimed invention. *Id.* If any one of these three requirements is not met, a rejection for obviousness cannot stand.

The combination of Muir with Shih alone, with Chen alone, or with both Shih and Chen cannot render obvious any of the claims because none of these combinations satisfies all three requirements for a *prima facie* case of obviousness. For example, none of these combinations teaches or suggests each and every feature of any of the claims. As explained above, Muir does not teach or suggest that “each of the compartments is arranged as a protruding element from the container.” Neither Shih nor Chen cures this deficiency.

Accordingly, Applicants respectfully request withdrawal of the § 103 rejections over Muir in view of Shih alone, in view of Chen alone, and in view of both Shih and Chen.

Claim Rejection for Double Patenting

On pages 10-11 of the Action, the PTO provisionally rejects claims 1, 6 and 19 for nonstatutory obviousness-type double patenting over claims 1, 5 and 24 in co-pending U.S. Pat. App. No. 10/733,767 (“the ‘767 application”). Applicants respectfully submit that none of the present claims can be obvious in view of the ‘767 application because the ‘767 application does not teach or suggest that “each of the compartments is arranged as a protruding element from the container.” Accordingly, Applicants respectfully request withdrawal of the double patenting rejection.

CONCLUSION

In view of the foregoing amendments and remarks, Applicants respectfully submit that all of the pending claims are now in condition for allowance. An early notice to this effect is earnestly solicited. If there are any questions regarding the application, the Examiner is invited to contact the undersigned at the number below.

The Commissioner is hereby authorized to charge any additional fees which may be required regarding this application under 37 C.F.R. §§ 1.16-1.17, or credit any overpayment, to Deposit Account No. 19-0741. Should no proper payment be enclosed herewith, as by a check or credit card payment form being in the wrong amount, unsigned, post-dated, otherwise improper or informal or even entirely missing, the Commissioner is authorized to charge the unpaid amount to Deposit Account No. 19-0741. If any extensions of time are needed for timely acceptance of papers submitted herewith, Applicants hereby petition for such extension under 37 C.F.R. §1.136 and authorize payment of any such extensions fees to Deposit Account No. 19-0741.

Respectfully submitted,

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